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10/055,189	01/25/2002	Sarah E. Campbell	D/A1496 (1508/3550)	9199

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Gunnar G. Leinberg, Esq.
Nixon Peabody LLP
Clinton Square
P.O. Box 31051
Rochester, NY 14603-1051

EXAMINER

QIN, YIXING

ART UNIT

PAPER NUMBER

2625

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,189

Applicant(s)

CAMPBELL ET AL.

Examiner

Yixing Qin

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/20/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

In response to applicant's amendment received 1/20/06, all requested changes have been entered.

Response to Arguments

Applicant's arguments filed 1/20/06 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made mainly in view of Shibata (U.S. Pub. No. 2002/0008883) and Suyehira (U.S. Patent No. 6,947,161). Both of these references relate to the requesting and ordering of consumables for a printing device. Other references have been cited for certain dependent claims. This rejection is made final due to the amendment of the claims and the rejection using the references mentioned above. Please see the new rejection below.

Drawings

A replacement drawing sheet for Fig. 1 was submitted on 1/20/06 and is accepted.

Claim Objections

Claims 31- 33 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s)

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in proper dependent form, or rewrite the claim(s) in independent form. The examiner believes that the first limitation of claims 31-33 of receiving a request is inherent in claims 1, 11, and 21 since a request would have to be received in order for information to be received based upon the request.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

I. Claims 1-3, 7-9, 11-13, 17-19, 21-23, 27-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Shibata (U.S. Pub. No. 2002/0008883).

1. Claims 1, 11, 21

A method comprising:

- **requesting, with a peripheral device, an identity of at least one supplier for at least one consumable for the peripheral device**
- Shibata discloses in P[0063] that the facsimile determines (i.e. requests) if the necessary information (which is shown in Fig. 3) for a sending a toner ordering request. One can see in Fig. 3 service depot (i.e. supplier) information
- **receiving information identifying the at least one supplier for the at least one consumable based on the request; and**
- Lines 5-10 of P[0063] discloses that if these information is determined to be in the registration unit 3 (i.e. receiving info identifying the supplier)
- **indicating with the peripheral device, the identified at least one supplier.**
- One can see in P[0064] the generated email 6A indicates the email address of the identified supplier.

2. Claims 2, 12, 22

The method as set forth in claim 1, further comprising:

- **indicating, at the peripheral device, when replacement of at least one of the consumables in the peripheral device is recommended, wherein the request is based on the indication of the recommended replacement.**
- Shibata discloses in Fig. 4, S2, S3 and S4 the checking of toner and the need for toner replacement. P[0062, 0063 and 0064] further describes this in detail.

3. Claims 3, 13, 23

The method as set forth in claim 1, further comprising:

- **retrieving information about the peripheral device making the request, wherein the identifying the at least one supplier is based on the retrieved information.**
- Shibata discloses in P[0063], line 3, that terminal information is needed in order to create an email requesting a refill toner. One can see in Fig. 3 that the terminal information contains information about the fax machine.

4. Claims 7, 17, 27

The method as set forth in claim 1:

- **wherein the received information further comprises information identifying a location of the identified at least one supplier, and the indicating further comprises indicating the location of the identified at least one supplier.**
- Shibata discloses in Fig. 3 and 7A the electronic location of a supplier by identifying its email and fax number.

5. Claims 8, 18, 28

The method as set forth in claim 1 further comprising:

- **submitting, with the peripheral device, an order for the at least one consumable to the at least one identified supplier.**
- Shibata discloses this step in S4 of Fig. 4

6. Claims 9, 19, 29

The method as set forth in claim 8 further comprising:

- **processing the submitted order; and**
- Shibata discloses in P[0067-0068] the processing of the order by a service depot.
- **supplying the at least one consumable for the peripheral device.**
- Shibata discloses in P[0070] the verification of the supplying and refilling of the toner.

7. Claims 31, 32, 33

The method as set forth in claim 1 comprising :

- **receiving the request; and**

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- **identifying the at least one supplier for the at least one consumable based upon the request**
- These have been addressed in claim 1 above.

8. Claims 34, 35, 36

The method as set forth in claim 1, wherein :

- **said indicating the identified at least one supplier comprises at least one of displaying received identification information and printing received identification information.**
- One can see in Figs. 3, 6A and 7A various ways to identify and display the service depot 16.

9. Claims 37, 38, 39

The method as set forth in claim 1, wherein :

- **the peripheral device is a device selected from a printer, copy machine, and a facsimile machine.**
- Shibata discloses in P[0034] his invention is an Internet fax machine.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

II. Claims 4, 14, 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata (U.S. Pub. No. 2002/0008883).

10. Claims 4, 14, 24

The method as set forth in claim 3 :

- **wherein the retrieved information about the peripheral device identifies a location of the peripheral device and the identifying of the at least one supplier is based on the identified location of the peripheral device.**
- Shibata does disclose in P[0047] and Fig. 3 a TTI (transmitter terminal information) that identifies the facsimile. Shibata does not explicitly teach that the retrieved information contains the location of the peripheral device, the TTI information is used to identify the facsimile device (which the also point of

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location information of a peripheral device as claimed). Therefore, it would have been obvious for one of ordinary skill to use an analogous method of identifying a peripheral device (such as using the location of the device). The motivation of using the TTI is to identify the facsimile so that the correct toner can be ordered.

- In P[0048] Shibata discloses that there are additional information including the type of toner to be ordered in association with the service depot system 16. The above TTI information identifies the facsimile and that information is associated with the service depot. Shibata does not explicitly disclose that the service depot chosen is based upon the TTI information of the facsimile. However, in P[0048], Shibata discloses that the registration information can contain information about the type of toner, which is based upon the identified facsimile. Thus, it would be obvious to one of ordinary skill in the art at the time of invention to know that the service depot chosen is based, at least indirectly, upon the TTI (i.e. location) of a facsimile device. The motivation would be to allow the correct consumables to be ordered and delivered.

II. Claim 5, 15, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable

Shibata (U.S. Pub. No. 2002/0008883) in view of Suyehira (U.S. Patent No. 6,947,161)

11. Claims 5, 15, 25

The method as set forth in claim 1:

- **wherein the received information further comprises information identifying a quantity of the at least one consumable at the identified at least one supplier, and the indicating the identified at least one supplier further comprises indicating the identified quantity of the at least one consumable.**
- Fig. 7A of Shibata discloses an e-mail indicating that toner is available and will be delivered soon. However, the Shibata reference does not disclose information identifying a quantity of the consumable at the supplier. The secondary reference, Suyehira, discloses in column 6, line 55-58, that if the orderer in the Suyehira printer orders a component that is no longer available (i.e. the quantity is 0), the order tracker keeps track of this information.
- Both references are in the art of ordering consumables for a printing device when the amount of the consumable is low. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included combined the Shibata and Suyehira inventions to allow the combined invention to be able to identify, at least, that an ordered consumable is no longer available for delivery. The motivation would be to allow an user to know if the user needs to look elsewhere for the consumable or to upgrade an existing printing machine because it might be going out of date.

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III. Claims 6, 16, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable

Shibata (U.S. Pub. No. 2002/0008883) in view of Suyehira (U.S. Patent No. 6,947,161).

in view of the Office Depot Website (previously cited)

12. Claims 6, 16, 26

The method as set forth in claim 1:

- **wherein the received information further comprises information identifying a price of the at least one consumable at the identified at least one supplier and the indicating the identified at least one supplier further comprises indicating each identified price of the at least one consumable.**
- Shibata discloses the invention as cited in claims 1 (11, 21). Neither Shibata nor Suyehira discloses the identification of a price of the consumable. The Suyehira reference, however, discloses in Fig. 1, and column 5, lines 12-17 that the Suyehira invention has a browser capable of accessing the Internet, which means it can access web pages. As previously mentioned, the Office Depot website contains various toner cartridges at various prices.
- All references are in the art of printing consumables. The Office Depot website was merely cited to show a price for cartridges that can be ordered. Combining the Shibata and Suyehira inventions, one can obtain a device capable of accessing the internet to obtain such information as the prices of consumables listed in the Office Depot website as cited in the previous Office Action. Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to create a device capable of obtaining price information of a consumable. The motivation would be to allow a user to know how much the consumable is going to cost.

IV. Claims 10, 20, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable

Shibata (U.S. Pub. No. 2002/0008883) in view of Borg et al (U.S. Patent No. 6,982,802

– “Borg”).

13. Claims 10, 20, 30

The method as set forth in claim 9:

- **wherein the processing the submitted order further comprises receiving payment for the at least one consumable.**
- Shibata discloses the invention as cited in claims 9, (19, and 29). Shibata does not explicitly disclose the paying for the order of a consumable. However, the secondary reference, Borg, discloses in column 5, lines 47-67 and column 6,

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lines 1-4 the purchasing of a consumable and deciding if purchase discounts are available.

- Both references are in the art of ordering consumables for a printing device. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the inventions from Shibata and Borg to have included payment processing as part of the ordering process. The motivation would be to let a user know how much money a particular toner cartridge costs.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

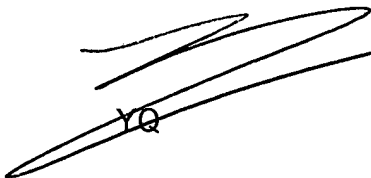
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381.

The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


YQ


TWYLER LAMB
-MARY EXAMINER
Supervisory Patent